

## REMARKS

Applicants respectfully request consideration of the subject application. This Response is submitted in response to the Office Action mailed November 8, 2006. Claims 1-4 and 6-23 are pending. Claims 1-4 and 6-23 are rejected. In this Amendment, claims 1, 14, 17 and 22 have been amended. No new matter has been added.

### 35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-4, 6-9, 12, 14-17 and 19-23 under 35 U.S.C. § 103(a) as being unpatentable over O'Halloran (U.S. Patent No.: 6,450,883, hereinafter "O'Halloran") in view of Baerlocher, et al (U.S. Patent No.: 5,788,573, hereinafter "Baerlocher").

O'Halloran is directed to a "double-up" bonus game feature. At column 1, lines 26 and 27, O'Halloran discloses that such features "have proved very popular with players of gaming machines". As explained at column 1, lines 18-23, in the "double-up" scenario, the player wagers winnings from a first game to play the feature. The "double-up" feature typically involves a binary choice, with the winnings being either doubled or lost, depending on the choice made. O'Halloran also mentions, as background, a variation of this type of game in the form of a "beat the dealer" game.

O'Halloran merely discloses this "double-up" bonus game feature. The contribution that O'Halloran claims to make is to offer a greater variety of choice (see column 1, lines 40-45). O'Halloran describes allowing a player to choose one card, the chosen card dictating whether the player has lost the winnings of an underlying game, or doubled (or tripled or quadrupled) the winnings of the underlying game. For example, O'Halloran describes a game in which the player chooses from three rows of cards, each row containing two, three or four cards, with a chance to double, triple or quadruple their winnings, respectively. The chance of winning is 1 in 2, 1 in 3, or 1 in 4. (See column 3, lines 37-45 and column 4, lines 1-7). Thus, in O'Halloran, the choice of a card has odds that are inversely proportional to the number of possible selections within the respective game choice. Furthermore, O'Halloran does not contemplate any format, other than a card game, for the "double-up" feature.

Baerlocher is directed to a wheel of fortune game "which is compatible with small prize odds such as odds of one in one million or more" (see column 4, lines 45-50). One of the methods used to achieve this is to provide a "hierarchy of wheels of fortune wherein the result from one wheel spin has an effect on the other wheel spin... providing odds of winning the grand prize which is a product of the odds on two or more different spins and thus diminishing the overall odds."

Claims 1-4 and 6-16 and 21

Claim 1 of the present application defines a gaming machine comprising *inter alia* the combination of the following features:

1. On the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets;
2. The prize outcomes of prize set are displayed to the player prior to the player selecting a prize set;
3. At least one of the prize sets displays at least two different winning outcomes;
4. The prize outcomes of each prize set are independent of any prize awarded in the underlying game on the occurrence of the predefined triggering event;
5. Each prize set has the same number of potential outcomes.

Similar limitations are included in independent claims 14 and 21.

Applicants note, in particular, the effect of the combination of features 1, 2 and 3. The player is offered a choice of a plurality of prize sets, each the prize sets being different. Each of the prize sets is displayed, enabling them to be evaluated by the player prior to making a selection. Within at least one prize set, there are at least two different winning outcomes. Accordingly, the player is provided with control over the prize set from which an outcome is selected. The

choice is engaging to the player because at least one prize set has two or more potential winning outcomes.

In contrast, in O'Halloran, the player is not provided with an engaging choice of different prize sets that they can evaluate prior to making a selection. Instead, the player is presented with an opportunity to double, triple or quadruple their existing win, while also risking losing their existing win. In O'Halloran, therefore, the player is not choosing between prize sets, but is instead choosing between "double-up", "triple-up" and "quadruple-up" games (i.e., double-or-nothing).

In addition, O'Halloran's "double-up" feature requires a direct (inverse) relationship between the chances of winning and the amount by which the prize from the underlying game is multiplied. Providing two different winning outcomes is inconsistent with this aspect of the "double-up" feature.

Furthermore, O'Halloran's "double-up" feature is a continuation of an underlying game. O'Halloran's "double-up" feature is not independent of a prize awarded in an underlying game, as claimed.

Moreover, the "double-up" feature described by O'Halloran requires a different number of prize outcomes. For example, as described above, O'Halloran requires two, three or four prize outcomes.

The Examiner submits Baerlocher discloses a bonus game in which “upon defining the prize won the several other possible prize outcomes are displayed to the user (see Figures 4 & 6).” Baerlocher does not provide any choice of different prize sets at all. Although in figure 4 & 6, all three wheels are displayed, the player has no choice, following a triggering event, as to which wheel to play. As explained above, O’Halloran does not teach providing the player with an engaging choice of different prize sets.

The Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of the invention to include prizes that are independent of the prize awarded in the underlying game of O’Halloran in light of the teaching of Baerlocher. Applicants respectfully disagree.

O’Halloran merely discloses a “double-up” feature, and that with this feature, a dependent relationship between the win of the underlying game and the available prize from the game is necessary. It is not a case where people designing “double-up” games were not aware of the option that prizes in a feature game may be independent from any win in the underlying game, but more a case of knowledge that prize independence is not appropriate for this type of game.

The Examiner further submits, as motivation for the modification of O'Halloran: to "avoid player perception of being penalized for getting a bonus event on a small win in the underlying game." Applicants respectfully disagree.

There is no such penalty in the double-up feature of O'Halloran. Instead, the player is provided a choice to multiply their winnings by, in the example provided, a factor of two, three or four, and this option is provided no matter what size the underlying win was. There is no penalty to the player because the amount that can potentially be won is, by design, directly proportional to the amount wagered, which is the amount won in the underlying game.

The Examiner provides an alternative motivation: to "give the player the perception of a greater amount of total prize possibilities in a similar fashion to the spinning of the reels of a traditional slot machine." Again, Applicants respectfully disagree.

Spinning reels of a slot machine have no relevance to the present invention.

Furthermore, as described above, the moment that the prize becomes independent of the win in the underlying game, the game ceases to become a "double-up" feature, and becomes something else.

Applicants submit that even if one of skill in the art was motivated to offer more prize possibilities, one of skill in the art would simply modify O'Halloran

to provide additional choices with, for example, a prize of five, six or seven times the amount won in the underlying game.

Furthermore, Applicants submit it is not obvious to modify O'Halloran to provide prize sets with the same number of potential outcomes. Again this change is contrary to the "double-up" type game taught by O'Halloran and Applicants cannot locate any motivation, teaching or suggestion in either O'Halloran or Baerlocher to make this modification.

First, O'Halloran and Baerlocher are incompatible with one another. O'Halloran is directed to a "double-up" feature, providing a good odd of winning. For example, O'Halloran discloses the odds of winning are 1 in 2, 1 in 3 or 1 in 4, depending on the choice made. In contrast, Baerlocher is directed to providing major prizes, such as progressive prizes, using a wheel game. Thus, Baerlocher is directed to a game in which the odds of winning are on the order of one in one million (or even more).

Second, the object of O'Halloran is to provide the player with a greater variety of choice (see column 1, lines 40-45). In the game taught by O'Halloran, the player is given two choices, one as to which row of cards to select and the other as to which card to choose in the row. Changing the card game to a wheel game, as suggested by the Examiner, would eliminate the second choice and, therefore, be contrary to the object of O'Halloran.

Third, even if it is assumed for present purposes that a skilled person would, at the relevant date, extract a wheel game theme from Baerlocher, independently of the requirement for a hierarchy of wheels, and apply that theme to O'Halloran (which the Applicant denies), then the result would be to have a player choose between a two segment wheel, three segment wheel and four segment wheel, each wheel having one win segment and respectively one, two or three losing wheel segments, contrary to the presently claimed invention.

#### Claim 17

Further to the arguments presented above, Claim 17 requires inter alia that each prize set has the same number of potential outcomes. As explained above in relation to claim 1, modifying O'Halloran to provide this feature is not obvious because the moment the modification is made, the game ceases to be a "double-up" feature. The same can be said for making the prize outcomes independent of any prize awarded for the underlying game.

#### Claim 20

Further to the arguments presented above, Claim 20 also requires there to be the same number of potential outcomes and, therefore, is patentable for at least the reasons set out above. Claim 20 also requires that the prize outcomes be



displayed to the player, which informs their choice, given that at least one prize set has at least two different winning outcomes. In addition, claim 20 requires inter alia that there are at least two winning outcomes in at least one set of prize outcomes that are displayed to a player prior to the player making his or her choice and that the theoretical return is increased. The player then has a choice as to what prize outcomes are available in the knowledge that no matter which choice is made, the theoretical return is increased.

Again, while some of the individual features of claim 20 may, in hindsight, be able to be found separately in O'Halloran or Baerlocher, due to the differences in the objects of the games, the prizes offered, and how their games are played, it would not be obvious to one of skill in the art to make a selection of the features of claim 20 to the extent they are present in O'Halloran and Baerlocher and combine them to result in the invention claimed in claim 20, or any other claim of the subject application.

#### Claim 21

Further to the arguments presented above, the Examiner submits the "Bankrupt" feature disclosed by Baerlocher does not result in a loss of the stake wagered on the base game but merely returns the player to the beginning of the game. Applicants respectfully disagree. Applicants refer to the cycle of steps

112, 114, 132 and 134 shown in Figure 1, which indicates that by virtue of decision step 114, if the "Bankrupt" feature occurs, then the process does not involve step 116 of evaluating for a winning combination and accordingly any win from the underlying game would be lost.

#### Claims 22 and 23

Further to the arguments presented above, Applicants respectfully disagree that Baerlocher describes wheels of different volatility from which the player chooses. Applicants disagree that it would be obvious to separate the hierarchy of wheels taught in Baerlocher into individually playable wheels, and also offer the player the choice as to which wheels to play, and then also apply these wheels somehow into the "double-up" type game taught by O'Halloran.

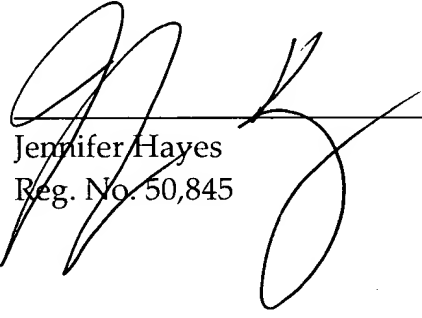
Thus, the cited art fails to teach or suggest all of the limitations of independent claims 1, 14, 17 and 21-23. Claims 2-4, 6-13 and 18-20 depend, directly or indirectly, from one of the foregoing independent claims. Applicants, accordingly, respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jennifer Hayes at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,  
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